

REMARKS

The holding of allowable subject matter in claim 24 is gratefully acknowledged. This claim has been put in independent form. Applicant respectfully submits that this amendment does not narrow the scope of the claim.

Claims 10, 13-14, and 25 have been cancelled. New independent claim 30 is advanced along with some dependent claims. Claims have been amended and/or cancelled to advance prosecution. This is done without prejudice or disclaimer. Applicant does not concede the non-patentability of the cancelled subject matter. Applicant reserves the right to pursue such subject matter in this application, or a continuing or divisional application.

The word “and” is added to claim 18. This is a purely grammatical change, is not in response to any rejection or objection, and does not change the scope of the claim.

Claim 23 is amended to make the wording consistent with new claim 30. These changes are purely formal in nature, not in response to any rejection or objection, and do not change the scope of the claim.

Objection to drawing

The Examiner objects to claim 10 relating to the term “encased. New claim 30 more clearly defines the intended structure, in conformity with the drawing. Claim 24 has been amended to state “at least partially encased,” which is also in conformity to the drawing, and is a slightly broader wording than “encased.” Applicant respectfully submits that the objection to the drawing in this respect should therefore be withdrawn.

The statement that the drawings do not show a gap between the lips is respectfully traversed. This gap – or absence of lips – is shown along axis B-B in fig 2B. The specification points this out at p. 3, line 15. The term “absence of lips” is equivalent to the term “gaps

REMARKS

between the lips” and is fully illustrated in the existing drawing. The law does not require the claims to have identical language to the specification, so long as the language of the claims is supported by the text & drawing. Nevertheless, in an effort to advance prosecution, the term “absence of lips” has been substituted for the word “gap” in claims 22 and 24. Applicant respectfully submits that substitution of this synonym does not change the scope of the claims, and is merely pedantic in nature.

Objection to the specification

The specification supports that there are gaps – also known as absence of lips – between the lips described at page 3, line 15. This objection is therefore respectfully traversed. The language of the claims does not have to be identical to that of the specification in order for the language to be supported. Nevertheless, in an effort to advance prosecution the term “absence of lips” has been substituted in the claims. Applicant respectfully submits that this change is not a narrowing amendment and is in fact purely pedantic.

Claim objections

In the version of the claims appearing above, the numbering has been corrected. Applicant apologizes for this typographical error. Applicant respectfully submits that this renumbering does not change the scope of any claim.

Claim 13 has been amended to delete the repeated language. Applicant respectfully submits that this change is typographical in nature and does not change the scope of the claim.

REMARKS

Objection to the word “standard”

Applicant respectfully submits that, in summarizing Applicant’s argument, the Examiner mischaracterizes it.

Applicant has demonstrated that there are currently standard sizes for business and credit cards, with reference to published literature. The Perego reference also makes reference to standard sized credit cards. The Examiner has presented nothing but speculation for her position that these standards might be indefinite or change in the future. There are no non-standard credit cards, so far as Applicant knows – and those business cards that currently exist that are non-standard are known to be non-standard. The Examiner has not presented a *prima facie* case of indefiniteness here.

Even units of measure such as a centimeter are subject to standards which define them. Those are published ISO standards, just like the standards that define the size of credit cards. The standards for centimeters and millimeters could change also. The Examiner does not object if units of measure like the centimeter are used. This is logically inconsistent. Those units of measurement are also defined by published standards, which could change in the future.

However, even if a standard were to change, then it would still be the standard and the claims would cover it.

Nevertheless, the phrase including the word “standard” has been deleted from allowed claim 24. Applicant respectfully submits that this is not a narrowing amendment.

New independent claim 30 also does not recite the standard size. That limitation is in a dependent claim, as is the wallet size limitation.

REMARKS

Art rejections

The art rejections are respectfully traversed.

Claim 22

The prior arguments with respect to claim 22 are incorporated by reference and supplemented as follows.

The Examiner says that elements 14 and 16 constitute gaps between the lips in elements 10 and 12 of Helmer. Applicant respectfully submits that this is a mischaracterization of the reference. Elements 14 and 16 contain continuations of the lips in elements 10 and 12, not gaps between them.

Applicant respectfully submits that the language substituted in the claim “absences” rather than “gaps” is equivalent to the prior language and does not narrow the scope of the claim, the Examiner having read “gaps” on elements 14 and 16 being a misconstruction of the reference. Nevertheless, it should be clear that there are no absences of lips in Helmer.

Rejection of claims 10, 13, 14, 28, and 29 over Perego

Applicants respectfully submit that this rejection fails to satisfy the requirements of 37 CFR 1.104, because rejections of several claims with different limitations are grouped together and it is impossible to determine how any one claim is read on the reference. Correction is respectfully requested.

REMARKS

Rejections over Helmer

The prior arguments with respect to this reference are incorporated by reference herein and supplemented as follows.

The Examiner states that the distinction of intended use cannot give rise to patentability. Applicant respectfully submits that this is a mischaracterization of the law. There is no prohibition on patenting an old device for a new use.

In fact, though, the device of Helmer cannot be used for a computer medium. It is the wrong shape and size. It is designed for mounting a license plate on a car. It is also not clear that the materials of this device would be compatible with storing a computer readable medium. For instance, the device is designed to bend with a license plate, per col. 2, lines 60 et seq. This feature would be extremely undesirable with a holder for a computer medium, where bending of the medium would result in dysfunction or breakage – and therefore resistance to bending, except as necessary for insertion, would be desirable.

Claims 15

Claim 15 recites first and second means to which storage media can be detachably attached. The Examiner purports to find this teaching in Perego in view of col. 5, lines 56-58. Applicant respectfully submits that the Examiner mischaracterizes the reference.

Perego introduces the terms storage unit and memory unit. The term storage unit apparently refers to a type of disc 7. The term memory unit seems to refer to a microchip 17a. The storage unit is removable per col. 3, lines 46-47. Applicant does not see that the memory unit is removable. Memory units are said to be integrated onto the card, per par. 0036. Applicant does not believe that the reference teaches or suggests that first and second storage

REMARKS

media can be respectively attached to first and second means, per the recitations of claim 15.

Applicant accordingly respectfully submits that the Examiner has failed to make a *prima facie* case against claim 15.

Claim 18 -- Perego

Applicant previously stated:

This claim recites that the holder has an opening approximately the size of the storage medium.

The Examiner purports to find this limitation in Fig. 4 of the Perego reference. Applicant respectfully submits that the Examiner mischaracterizes the reference. Applicant sees in Fig. 4 that there is a surface recess 11, not an opening. Applicant accordingly respectfully submits that the Examiner has failed to make a *prima facie* case against claim 18

The Examiner responds

Applicant defines the opening in terms of a storage medium which is not part of the claimed invention. The opening shown in Perego is the same size as a storage medium.

Applicant respectfully submits that the Examiner has mischaracterized Applicant's argument. Applicant has argued that the claim recites an opening, while the art shows a recess, and that a *recess is not an opening*. The Examiner's comments do not appear to be related to the argument. Applicant respectfully submits that this is improper.

Applicant would further like to point out that claim 18 recites an accommodation means that is deformable. It is not clear that the accommodation means in Perego is deformable. Applicant accordingly respectfully submits that this feature is also not taught or suggested by the

REMARKS

reference. New claim 35 clarifies that the deforming comprises bending the holder along an axis, which is clearly not taught or suggested by Perego.

Claim 16-17

The prior comments with respect to this rejection are incorporated by reference and supplemented as follows.

In rejecting these claims, the Examiner combines Perego and Walker. Applicant respectfully submits that Walker cannot be combined with Perego. Walker was implemented at a time when discs were much larger and relates to wall mounting. One of ordinary skill in the art would not have looked to Walker to supplement Perego. Perego relates to integrating an optical and electronic memory into a card together. It is unclear why one of ordinary skill in the art would be motivated to combine this unit, which is an active electronic unit with a passive wall storage unit like Walker. The only motivation to do so would come from Applicant's disclosure and claims, which would be an improper hindsight reconstruction.

With respect to claim 17, the Examiner states again without support that Perego is adapted to hold two small form factor optical discs. Applicant finds no such teaching or suggestion. Applicant accordingly respectfully submits that the Examiner has failed to make a *prima facie* case against claim 17.

REMARKS

Applicant respectfully submits that he has addressed each issue raised by the Examiner — except for any that were skipped as moot — and that the application is accordingly in condition for allowance. Allowance is therefore respectfully requested.

Respectfully submitted,

By */Anne E. Barschall/*
Anne E. Barschall, Reg. No. 31,089
Tel. no. 914-332-1019
Fax no. 914-332-7719
Date of printing: December 17, 2008

In house contact at assignee:
Michael Belk
Reg. No. 33,357
Tel. # 914-333-9643